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EXAMINER				
MENDOZA JR, JORGE				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/675,434

Applicant(s)

KARAOGUZ ET AL.

Examiner

JORGE MENDOZA JR

Art Unit

4126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/30/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Claims **1-31** are presented for Examination.

Priority

2. A reference to the prior application No.**60/478,246**, filed on June 13, 2003; application No. **60/432,472**, filed on December 11, 2002; and application No. **60/443,894**, filed on January 30, 2003 have been inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76). The claim for benefit of relying on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c) is acknowledged.

Information Disclosure Statement

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. Incorporated references (Application No. 60/478,287; Application No. 60/448,705; Application No.60/457,179; Attorney Docket No. 14185US02; and Attorney Docket No. 14274US02) are disclosed in paragraph [02] of the specification.

Specification

4. The disclosure is objected to because of the following informalities: The Serial Numbers (US Patent Application Numbers) are missing in paragraph [02] of the Incorporated by Reference section. Appropriate correction is required.
5. The disclosure is objected to because of the following informalities: Information provided in paragraph [46] is incorrect. According to Figure 1C, the "Close Family" group corresponds to reference character **143**, not **144** as indicated in the specification. Appropriate correction is required.
6. The disclosure is objected to because of the following informalities: Information provided in paragraph [46] is incorrect. According to Figure 1C, the "Son's Friend's" group corresponds to reference character **144**, not **143** as indicated in the specification. Appropriate correction is required.

Drawings

7. The drawings are objected to because reference character 'C' of Figure 5 is labeling an incorrect location as stated in the specification. According to the paragraph [69] of the specification, reference character 'C' should be labeling where 'the first party **501** accesses the third-party channel **504** using a media guide user interface **502** on a PC **503**'. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims **1-8, 11-18, & 21-28** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1-23** of copending Application No. **10/675,358**. Although the conflicting claims are not identical, they are not patentably distinct from each other because they have the same meets & bounds and are essentially indistinguishable.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

With respect to Claim 1, the claimed "receiving at least one condition, at a first location, the at least one condition defining when an indication of media consumption activity is sent by the first location to at least a second location, via the communication

network" is met by claim 1 of the co-pending application that teaches a notification being sent to a 2nd user regarding a media request by a 1st user, if a pre-defined characteristic for the requested media matches that of the selected. The claimed "receiving a request for media consumption, from a user at the first location, sending at least one indication of media consumption activity to the at least a second location, via the communication network, if the at least one condition is met" is met by claim 1 of the co-pending application that teaches a media request being made by a first user and if a media characteristic matches a user-selected characteristic, a notification is sent out to a second user. The claimed "refraining from sending at least one indication of media consumption activity to the at least a second location, via the communication network, if the at least one condition is not met" is met by claim 1 of the co-pending application that teaches a 2nd user not being notified of media requested by a 1st user if an appropriate matching does not occur.

Claim 2 is met by claim 2 of the co-pending application.

Claim 3 is met by claim 3 of the co-pending application.

Claim 4 is met by claim 4 of the co-pending application.

Claim 5 is met by claim 5 of the co-pending application.

Claim 6 is met by claim 6 of the co-pending application.

Claim 7 is met by claim 7 of the co-pending application.

Claim 8 is met by claim 8 of the co-pending application.

Claims 11-18 & 21-28 contain the same limitations as discussed in Claims 1-8 above. Therefore, they are rejected under the same rationale.

10. Claims **9, 10, 19, 20, & 29** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. **10/675358** in view of **Lu** (US Patent **7,065,778**).

This is a provisional obviousness-type double patenting rejection.

With respect to Claim **9**, the claimed "wherein the at least one indication of media consumption activity comprises at least one of a title, a subject, a user identifier, a source of media being accessed, a media channel type, a mode, a media format, a genre, a language, a subject, and an artist" is not explicitly taught by the co-pending application.

However, the Lu et al. reference teaches the transmittal of a television program from a first user at PVR's **200A** and/or **200B** to a second user at PVR **200** once a requested media program is being broadcasted to the first user (Fig.3-5; col.6, lines 45-58 & col.9, lines 8-23).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Lu with those of the co-pending application in order to provide a complete indication of the media consumption activity of a first user. A person with ordinary skill in the art would have been motivated to make the modification to the co-pending application in order to provide an accurate communication of the media consumption activity of a first user to a second user.

With respect to Claim **10**, the claimed "wherein the at least one condition is received from a location remote from the first location, via the communication network" is met by the Lu reference that teaches the transmittal of a 'condition' from a user at

PVR **200** to an EPG server **304**, which in turn sends the 'condition' to PVR's **200A** & **200B** (Fig. 3; col.6, lines 45-54).

Claims **19, 20, & 29** contain the same limitations as discussed in Claims **9 & 10** above. Therefore, they are rejected under the same rationale.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims **1, 5-9, 11, 15-20, 22-24, & 27- 29** are rejected under 35 U.S.C. 102(e) as being anticipated by **Barness et al. (US Patent Application Publication 2003/0115585)**.

With respect to Claim **1**, the claimed "receiving at least one condition, at a first location, the at least one condition defining when an indication of media consumption activity is sent by the first location to at least a second location, via the communication network" is met by Barness et al. that teach a 1st user, receiver **104**₁, using a group identification (ID) entry **414** in a record **400** to allow selective communication of

viewership information to a 2nd user, receiver **104N**, via a communication network, **128** (Fig.1 & 4; paragraphs [0028], [0032], & [0047-0049]).

The claimed “receiving a request for media consumption, from a user at the first location” is met by Barness et al. that teach a receiver **104**, being used by a first user to compile & send an individual viewership record **400**, each time the user requested specific media to be viewed (Fig.4; paragraph [0047]).

The claimed “sending at least one indication of media consumption activity to the at least a second location, via the communication network, if the at least one condition is met” is met by Barness et al., that teach the delivery of an individual viewership record **400**, via communication network **128**, from a 1st user to a 2nd user only if the 2nd user is associated with the group identification (ID) stored in the group ID entry **414** of the viewership record (Fig.1; paragraphs [033], [0048] & [0049]).

The claimed “refraining from sending at least one indication of media consumption activity to the at least a second location, via the communication network, if the at least one condition is not met” is met by Barness et al., that teach the use of a group ID stored in the group ID entry **414** of the viewership record **400** in determining where or not a 2nd user receives the viewership record, as previously discussed above.

With respect to Claim **5**, the claimed “wherein the media comprises at least one of audio, a still image, video, real time video, and data” is met by Barness et al. that teach the method of claim 1 where the programs being received by a receiver **104** include ‘pay-per-view movies, view-on-demand movies, broadcast television, network channels, syndicated channels and the like’ (paragraph [0028]).

With respect to Claim **6**, the claimed "wherein consumption comprises at least one of playing audio, displaying a still image, displaying video, and displaying data" is met by Barness et al. that teach the use of a display device **204** and/or peripheral devices **206** in order to properly communicate information from the provider **102** to a user via the receiver **104** (Fig.2 and paragraphs [0034], [0035], & [0038]).

With respect to Claim **7**, the claimed "receiving an identifier identifying the at least a second location; and the identifier comprising at least one of a legal name, a given name, a screen name, a user identifier, a network identifier, an Internet protocol (IP) address, a media access control (MAC) address, and an electronic serial number" is met by Barness et al that teach the use of a group identifier (ID) **414** in an individual viewership record **400** in identifying at least a second receiver **104** (Fig.4; paragraphs [0046] & [0048]).

With respect to Claim **8**, the claimed "wherein at least one user-defined characteristic comprises at least one of a day, a date, a time, time period, a user identifier, a source of media being accessed, a media channel type, a mode, a media format, a genre, a language, a subject, and an artist" is met by Barness et al. that teach the use of a group identifier (ID) in controlling whether or not a 2nd user, at receiver **104**, would receive the group viewership indicator (Fig.1; paragraph [0048]).

With respect to Claim **9**, the claimed "wherein the at least one indication of media consumption activity comprises at least one of a title, a subject, a user identifier, a source of media being accessed, a media channel type, a mode, a media format, a genre, a language, a subject, and an artist" is met by Barness et al. that teach the use

of a viewership record (400); containing a channel entry (402), a start time entry (404), a stop time entry (406), a duration entry (408), a location entry (410), an information entry (412), a group identification (ID) entry (414), and an anonymous flag entry (416) (Fig.4; paragraph [0047]).

Claim 11 is met as previously discussed with respect to Claim 1.

Claim 15 is met as previously discussed with respect to Claim 5.

Claim 16 is met as previously discussed with respect to Claim 6.

Claim 17 is met as previously discussed with respect to Claim 7.

Claim 18 is met as previously discussed with respect to Claim 8.

Claim 19 is met as previously discussed with respect to Claim 9.

With respect to Claim 20, the claimed “wherein the notifying comprises at least one of displaying an image, generating sound, and illuminating a light emitting diode representing the receipt of the at least one activity indication” is met by Barness et al. that teaches the use of graphical enhancements in representing viewership indicators, in the form of plain text messages, images, video, and/or other data formats (Fig.11; paragraphs [0042] & [0069]).

Claim 22 is met as previously discussed with respect to Claim 1. In addition, the Barness et al. reference teaches the use of a television (display device 204) coupled to a receiver (set top box 104) containing memory device (212) and having data structures (242) and a network device (216) (Fig.2; paragraphs [0035], [0037], & [0042]).

Claim 23 is met as previously discussed with respect to Claim 5.

Claim 24 is met as previously discussed with respect to Claim 6.

Claim 27 is met as previously discussed with respect to Claim 7.

Claim 28 is met as previously discussed with respect to Claim 8.

Claim 29 is met as previously discussed with respect to Claim 9.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 2-4, 10, 12-14, 21, 25, & 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Barness et al. (US Patent Application Publication 2003/0115585)** in view of **Lu (US Patent 7,065,778)**.

With respect to Claim 2, the claimed "wherein each of the first location and the at least a second location are associated with at least one of an Internet protocol (IP) address, a media access control (MAC) address, and an electronic serial number (ESN)" is not explicitly taught by the Barness et al. reference. However, in the same field of endeavor, Lu teaches a first location (PVR 200A) receiving a request for media consumption from a second location (PVR 200), and in which both locations have Internet Protocol (IP) addresses (col.10, lines 10-15 & lines 31-35).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of the Lu reference with those the Barness et al. reference in order to accurately communicate information to a wider array of users. A person with ordinary skill in the art would have been motivated to make the modification to the Barness et al. reference in order to reach a greater audience and to

make delivery of both the 'condition' and an 'indication of media activity' more secure and efficient among a first user to a second user.

With respect to Claim **3**, the claimed "the communication network comprises at least one of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and a wireless infrastructure" is met by Lu that teaches the use of the Internet **302**, coaxial cable, copper wire, fiber optics, wireless network, etc. coupling the devices of network **300** (col.2, lines 13-22; col.6, lines 39-54, lines 62-64; and Fig.3&4).

With respect to Claim **4**, the claimed "wherein the communication network is the Internet" is met as previously discussed with respect to claim 3 above.

With respect to Claim **10**, the claimed "wherein the at least one condition is received from a location remote from the first location, via the communication network" is met by the Lu reference that teaches the transmittal of a 'condition' from a user at PVR **200** to an EPG server **304**, which in turn sends the 'condition' to PVR's **200A & 200B** (Fig. 3; col.6, lines 45-54).

Claim **12** is met as previously discussed with respect to Claim **2**.

Claim **13** is met as previously discussed with respect to Claim **3**.

Claim **14** is met as previously discussed with respect to Claim **4**.

With respect to Claim **21**, the claimed "initiating, from the first location, an exchange of media between the first location and the at least a second location, if the at least one condition is met; and refraining from initiating, from the first location, an

exchange of media between the first location and the at least a second location, if the at least one condition is not met" is met by Lu that teaches the transmittal of a recorded media program from PVR 200A and/or PVR 200B to PVR 200 if the requested media program is being broadcasted and received by PVR 200A and/or PVR 200B (Figs.3&4, Abstract; col.2, lines 9-28; col.6, lines 45-58, & col.9, lines 8-23).

Claim 25 is met as previously discussed with respect to Claim 2.

Claim 26 is met as previously discussed with respect to Claim 3.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gutta et al. (US PG Pub US 2003/0066068) teaches a method of recommending T.V. programs by combining a user's profile with a 2nd user's profile; such as that of a friend, family member, or others.

Finseth et al. (US Patent 6,813,775) teaches a method of sharing user preference information among a 1st user and a 2nd user.

Murphy et al. (US PG Pub 2004/0250285) teaches a system in which two-way communication among set-top boxes can be conducted using text, audio, and/or video messages.

Art Unit: 2629

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jorge Mendoza Jr.** whose telephone number is (571) 270-5087. The examiner can normally be reached on Monday through Friday 7:30 am – 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Dennis Chow** can be reached at (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 8660217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jorge Mendoza Jr./
Examiner, Art Unit 4126

/Lun-Yi Lao/
Primary Examiner, Art Unit 2629